

REMARKS

This paper is submitted in response to the Office Action for the above-identified application mailed February 1, 2007. In the Office Action, Claims 71-73, 76, 79, 80, 89, 91-95, 99, 100 and 103 were rejected under 35 U.S.C. 102 for being anticipated by U.S. Pat. Pub. No. 2001/0034530. Claims 75, 78, 90, 97, 98, 101, 102, 104 and 105 were rejected as being obvious in view of the '530 Publication or obvious in view of the '530 Publication further in view of: U.S. Pat. No. 5,928,137; U.S. Pat. No. 6,761,561; and/or U.S. Pat. Pub. No. 2002/0035321

Under cover of this paper some of the claims of this application have been amended for editorial reasons. No claims have been canceled or added.

The Applicants now turn to the prior art rejections.

The primary basis for the rejections is the disclosure in the '530 Patent of a smart instrument 102 and a universal tracker 202. Both of these devices include components capable of emitting signals so that their positions can be tracked. It is stated that the smart instrument may deliver energy to the surgical site. The '530 Publication further discloses that the universal tracker is provided with an adapter 302 so it can be affixed to another tool.

The supposed relevance of these devices to the present claims is based on passage in the '530 Publication that the power to energize the navigation system components integral with these devices is supplied from "a *common* lithium

battery.”<sup>1</sup> The present rejection is based on the position that this disclosure means a single battery powers both the navigation components and the power consuming components of the associated tool.

In response to this position, the Applicant initially reproduces in their entirety the plural definitions of the word “common” in the *Merriam-Webster Dictionary*, 2004, paperback edition, page 145:

1: belonging to or serving the community: PUBLIC  
2: shared by a number in the group 3: widely or generally known, found or observed: FAMILIAR  
<~knowledge> 4 : VERNACULAR 3 <~names of plants>  
5: not above the average esp. in social status,

It is acknowledged that the first two definitions of “common” mean “shared.” However, the third definition is “well known.”

*Texas Digital Systems, Inc. v. Telegenix, Inc.*, 308 F.3d 1193 (Fed. Cir. 2002) cert. denied 126 S.Ct. 1332 (2006) considered the issue of how to interpret words in a patent when there are “multiple dictionary definitions.” In this situation, “the intrinsic record must always be consulted to identify which of the different possible dictionary meanings” is consistent with the words used by the inventor. 308 F.3d at 1203.

The intrinsic record of the '530 Publication is the rest of the publication. The relevant remaining sections of the '530 Publication disclose and illustrate a tracker device 200 the underside of which carries a battery holder 208. The adapter 302 is connected to the front of

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<sup>1</sup> U.S. Pat. Pub. No. US 2001/0034530 A1, Paragraph 69 (*Emphasis Added*)

the tracker for attaching the tracker to the instrument to be tracked. Absent from the description of these or any of the other components are either text or illustrations of any sort of electrical conductors between the tracker and the instrument to which it is attached.

The '530 Application illustrates only a single version of a smart instrument, an integral tracker-surgical instrument assembly. The instrument is a pointer 614. Given that such an instrument is passive, not powered, such disclosure does not suggest power sharing.

Thus, nowhere in this document is there any explicit or implicit description of how the batteries integral with the tracker and smart instrument navigation components power the associated instrument. Given the failure to include such disclosure, the logical conclusion is that the adjective-at-issue simply means that the battery is "well known."

The location of the word "common" in the '530 Publication further evidences that the adjective has the above meaning. Specifically, the word is part of the phrase "common lithium battery." Given the failure of the document to provide any other suggestion of power sharing, this would indicate that, in this Publication, the phrase-at-issue merely means that navigation components universal tracker or smart instrument can be powered by a "well known lithium battery."

With regard to the last point, the Applicants note that, as evidenced below, at the time the '530 Publication was drafted, lithium batteries were *not* used to power the

power consuming component of cordless powered surgical tools.

The only hint in the '530 Publication that the battery used to power the navigation components can also energize the associated surgical tool comes from the misinterpretation of a single word in this document. There is no other suggestion of power sharing.

In furtherance of this position, one the Applicants, Malackowski, who is also a named inventor of the system disclosed in the '530 Publication, takes this opportunity to submit a Declaration Under 37 CFR 1.132.

Before discussing the contents of this Declaration, the Applicants note that this Rule specifically allows the submission of evidence to traverse a rejection. The *Manual of Patent of Examining Procedure*, Sec. 16.07, goes on to state that, such a Declaration to attack the operability of a reference can be considered. Since the Malackowski Declaration now provides evidence describing why the '530 Publication is not operable with regard to teaching a shared tracker-instrument battery, the above Rule and *MPEP* Section make it clear that the Declaration must be considered.

Malackowski was part of the design team that constructed both the universal tracker and tracker-instrument combination unit that are disclosed in the '530 Publication.<sup>2</sup> As set forth by Malackowski, there are no features in the universal tracker that is the subject of

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<sup>2</sup> Malackowski Declaration, Paragraph 2.

this document that allow the battery integral therewith to power the instruments to which the tracker are attached.<sup>3</sup>

In regard to this issue, Malackowski observes that the subject tracker is designed to be used with a battery that is only capable of delivering a peak current of 0.5 amps and that is capable of supplying at least 2.5 watt hours of power.<sup>4</sup> These power and current requirements pale in contrast to those of the battery used to power the tool with which the tracker is used. That battery must be capable of delivering a peak current of 40 amps and supplying 10 Watt-hours of power.<sup>5</sup>

If one were to attach a shared battery to a tracker, one would have to provide a battery capable of providing much more power than the tracker itself would require. Providing this type of tracker-battery assembly would mean that, in instances where the high-power demands of a power consuming tool are not required, the assembly would include a battery much larger than actually needed. This would needlessly increase the weight and size of the assembly for the medical personnel using it. Alternatively, the medical facility would have to keep on hand different sized tracker batteries; small ones for when the power is not shared and larger ones for power sharing. This solution increases inventory burden on both the vendor and the medical facility.<sup>6</sup>

The only combination unit constructed included a passive instrument, the pointer. There was no effort to

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<sup>3</sup> Malackowski Declaration, Paragraph 5.

<sup>4</sup> Malackowski Declaration, Paragraph 3.

<sup>5</sup> Malackowski Declaration, Paragraph 4.

<sup>6</sup> Malackowski Declaration, Paragraph 5.

construct a combination unit wherein a single battery was able to power both the power generating unit integral with a surgical instrument and the power consuming components integral with the tracker.<sup>7</sup>

According to Malackowski, the use of the phrase "common lithium battery" in the '530 Publication is meant to teach that the tracker employs a well known lithium battery, the CR2 lithium battery. This is a type of battery found in amateur-level cameras.<sup>8,9</sup> The charge stored in this battery cannot supply the required current or Watt hours of power needed required by the surgical instruments to which the tracker to which the battery is attached.<sup>10</sup>

In further support of this position, Malackowski notes that, at the time the '530 Publication was drafted, his Assignee, a manufacturer of battery-operated powered surgical tools and their batteries, was not providing lithium-cell batteries to power its tools. The Assignee was, instead, providing batteries with NiCad cells. Malackowski is not aware of any manufacturer of battery powered medical equipment that, in 2001, was using lithium cells to power its tools.<sup>11</sup>

Thus, Malackowski, the inventor of the subject of the '530 Publication, knows of no reason why this publication should be interpreted as teaching that the battery used to

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<sup>7</sup> Malackowski Declaration, Paragraph 6.

<sup>8</sup> Malackowski Declaration, Paragraph 7.

<sup>9</sup> The capabilities of the CR2 battery can be verified by a number of different web sites. One such site is BATTERIES.COM; enter the search term "CR2".

<sup>10</sup> Malackowski Declaration, Paragraph 8.

<sup>11</sup> Malackowski Declaration, Paragraph 10.

power the navigation components of the devices of this publication can also be used to power an associated surgical instrument.<sup>12</sup>

Thus, there is nothing about the '530 Publication to suggest that the invention recited by the surgical tool assembly of the present claims which includes a handpiece with a battery for energizing the handpiece's power consuming unit and a tracking unit with an electric interconnect unit so that the tracker is energized by the handpiece's battery. Only this invention, not the assembly associated with the prior art publication, reduces both the size and weight of a surgical tool assembly that includes both a handpiece with a power consuming actuator and a tracking unit to monitor the position of the handpiece.

Further, the presently claimed invention does not increase the size or weight of powered tool that is used by the surgeon that does not require use of the tracker. All this surgeon has to do is remove the tracker.

In sum, it is respectfully submitted that the '530 Publication does not suggest a tool-and-tracker assembly having the structure or advantages of the presently claimed invention. The additional prior art documents cited in the Office Action similarly fail to disclose anything relevant to power sharing.

Accordingly, it is respectfully submitted that the claims remain directed to an assembly that is not suggested by the prior art and therefore are directed to an invention

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<sup>12</sup> Malackowski Declaration, Paragraph 9.

App. No. 10/617,077  
September 27, 2007 Response  
page 17

entitled to patent protection. Accordingly, since the claims and the other parts of this application are in an allowable state, the Applicant courteously solicits prompt issuance of a Notice of Allowance.

September 27, 2007

Respectfully submitted,

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